



ALTERNATIVE TO PTO/SB/08A/B (04/07)

Substitute for form 1449/PTO

# **INFORMATION DISCLOSURE STATEMENT BY APPLICANT**

(Use as many sheets as necessary)

Sheet 1 of 4

## **Complete if Known**

Application Number	10760,091
Filing Date	January 16, 2004
First Named Inventor	Thomas L. CANTOR
Art Unit	1641
Examiner Name	C. Cheu
Attorney Docket Number	532212000624

## **NON PATENT LITERATURE DOCUMENTS – SUBJECT TO PROTECTIVE ORDER**

Examiner Initials	Cite No.	Include name of the author (in CAPITAL LETTERS), title of the article (when appropriate), title of the item (book, magazine, journal, serial, symposium, catalog, etc.), date, page(s), volume-issue number(s), publisher, city and/or country where published.	T <sup>2</sup>
	1.	Declaration of Julia A. Miller in Support of Nichols Institute Diagnostics, Inc.'s Motion for Leave to File Amended Complaint, filed January 26, 2004	
	2.	Nichols Institute Diagnostics, Inc.'s Notice of Lodgement of Corrected Copy of Proposed Second Amended Complaint, Exhibit A to Declaration of Julia A. Miller in Support of Nichols' January 26, 2004 Motion for Leave to File Amended Complaint, filed February 23, 2004	
	3.	Declaration of Julia A. Miller in Support of Nichols Institute Diagnostics, Inc.'s Motion for Summary Judgment that the '790 Patent Claims are Valid and Infringed, filed February 28, 2005	
	4.	Declaration of M. Andrew Woodmansee in Support of Motion for Summary Judgment Pursuant to 35 U.S.C. § 102(b) by Defendants Scantibodies Clinical Laboratory, Inc. and Scantibodies Laboratory, Inc., filed February 25, 2003	
	5.	Declaration of Brigham A. Fordham in Support of Scantibodies' Motion for Judgment on the Pleadings for Lack of Standing and Failure to Join an Indispensable Party or, in the Alternative, to Join a Necessary Party Pursuant to FRCP 19, filed July 16, 2003	
	6.	Declaration of Peter R. Munson in Support of Nichols Institute Diagnostics, Inc.'s Opposition to Scantibodies' Motion for Judgment on the Pleadings for Lack of Standing and Failure to Join an Indispensable Party or, in the Alternative, to Join a Necessary Party Pursuant to FRCP 19, filed September 18, 2003	
	7.	Declaration of M. Andrew Woodmansee in Support of Scantibodies' Motion for Judgment on the Pleadings for Lack of Standing and Failure to Join an Indispensable Party or, in the Alternative, to Join a Necessary Party Pursuant to FRCP 19, filed September 24, 2003	
	8.	Declaration of Julia A. Miller in Support of Nichols Institute Diagnostics, Inc.'s Motion to Permit Service of its Supplemental Amended Complaint Under F.R.C.P. 15(d), filed November 24, 2003	
	9.	Declaration of Katherine L. Parker in Support of Scantibodies' Reply to Nichols' Opposition to Motion for Judgment on the Pleadings and for Attorneys' Fees, filed February 23, 2004	
	10.	Supplemental Expert Report of Larry W. Evans Pursuant to Rule 26(A)(2)(B), Fed. R. Civ. P.	
	11.	Supplemental Expert Report of L. J. Deftos, MD, JD, LLM	
	12.	Expert Report of Joseph O. Falkinham, III, Ph.D. Adopting Supplemental Expert Report of L. J. Deftos, MD, JD, LLM	
	13.	Rebuttal Expert Report of Joseph O. Falkinham, III, Ph.D.	
	14.	Rebuttal Expert Report of Ellen S. Vietta, Ph.D.	
	15.	Order Granting Scantibodies' Ex Parte Application for Leave to File Documents Under Seal, filed May 4, 2005	
	16.	Nichols Institute Diagnostics, Inc.'s Notice of and Ex Parte Application for Order to File Its Confidential Consolidated Declaration of April Alex in Support of Nichols' Opposition to Scantibodies' In Limine Motion Nos. 2 and 5 Under Seal, filed May 5, 2005	
✓	17.	Declaration of April Alex in Support of Nichols' Ex Parte Application for Order Sealing Its Confidential Consolidated Declaration of April Alex in Support of Nichols' Opposition to Scantibodies' In Limine Motion Nos. 2 and 5 Under Seal, filed May 5, 2005	

Examiner Signature	/Changhwa Cheu/	Date Considered	08/11/2008
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Attorney Docket Number	532212000624

18.	Confidential Consolidated Declaration of April Alex in Support of Nichols Institute Diagnostics, Inc.'s Opposition to Scantibodies' In Limine Motion Nos. 2 and 5, filed May 5, 2005	
19.	Scantibodies' Ex Parte Application For Leave to File Documents Under Seal With Oppositions to Nichols' Motions In Limine, Filed May 5, 2005	
20.	Declaration of Katherine L. Parker in Support of Scantibodies' Ex Parte Application For Leave to File Documents Under Seal, filed May 5, 2005	
21.	Declaration of M. Andrew Woodmansee in Support of Scantibodies' Oppositions to Nichols' Motions In Limine, filed May 5, 2005	
22.	Supplemental Exhibits to Joint Trial Brief [Volume 1 of 5], filed May 4, 2005	
23.	Nichols Institute Diagnostics, Inc.'s Notice of and Ex Parte Application for Order to File Exhibits 12-14, 16-17, 19, 22, 25-26 and 28-33 of the Supplemental Exhibits to Joint Trial Brief Under Seal, filed May 4, 2005	
24.	Declaration of April M. Alex in Support of Nichols' Ex Parte Application for Order to File Exhibits 12-14, 16-17, 19, 22, 25-26 and 28-33 of the Supplemental Exhibits to Joint Trial Brief Under Seal, filed May 4, 2005	
25.	[Proposed] Order Granting Nichols Institute Diagnostics, Inc.'s Ex Parte Application to File Exhibits 12-14, 16-17, 19, 22, 25-26 and 28-33 of the Supplemental Exhibits to Joint Trial Brief Under Seal, filed May 4, 2005	
26.	Deposition of Claude Arnaud, Exhibit No. 12	
27.	Deposition of Thomas Cantor, Exhibit No. 13	
28.	Deposition of Thomas Cantor, Exhibit No. 14	
29.	Deposition of Damon Cook, Exhibit No. 16	
30.	Deposition of Wolf-Georg Forssmann, Exhibit No. 17	
31.	Deposition of Ping Gao, Exhibit No. 19	
32.	Deposition of Thomas Godemeyer, Exhibit No. 22	
33.	Deposition of Markus Magerlein, Exhibit No. 25	
34.	Deposition of Markus Magerlein, Exhibit No. 26	
35.	Deposition of Michael Nordstrom, Exhibit No. 28	
36.	Deposition of K. Ramakrishnan, Exhibit No. 29	
37.	Deposition of K. Ramakrishnan, Exhibit No. 30	
38.	Deposition of Randall Ringold, Exhibit No. 31	
39.	Deposition of Stephen Scheibel, Exhibit No. 32	
40.	Deposition of Janet Sharp, Exhibit No. 33	
41.	Order Granting Nichols Institute Diagnostics, Inc.'s Ex Parte Application to File the Declaration of James V. Fazio, III in Support of Nichols Institute Diagnostics, Inc.'s Motion In Limine No. 10 to Preclude Counsel From Objecting to Rule 30(B)(6) Designations Under Seal, filed May 4, 2004	
42.	Order Granting Nichols Institute Diagnostics, Inc.'s Ex Parte Application to File Exhibits A, B, C, D, F, G, H, and J to the Consolidated Declaration of April Alex in Support of Nichols Institute Diagnostics, Inc.'s In Limine Motions Nos. 15-17 Under Seal, filed May 4, 2005	
43.	Order Granting Nichols Institute Diagnostics, Inc.'s Ex Parte Application to File Exhibits B and C of the Consolidated Declaration of Jane K. Babin in Support of Nichols Institute Diagnostics, Inc.'s In Limine Motions Nos. 19-20 Under Seal, filed May 4, 2005	
44.	Memorandum of Points and Authorities in Support of Scantibodies' Motion for Summary Judgment of Invalidity and Noninfringement, filed February 18, 2005	

Examiner  
Signature

/Changhwa Cheu/

Date

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45.	Declaration of Katherine L. Parker in Support of Scantibodies' Motion For Summary Judgment of Invalidity and Noninfringement, with Exhibits 1-39, filed February 18, 2005	
46.	Nichols Institute Diagnostics, Inc.'s Opposition to Motion For Summary Judgment of Invalidity and Non-Infringement, filed March 7, 2005	
47.	Declaration of Julia A. Miller in Support of Nichols Institute Diagnostics, Inc.'s Opposition to Motion For Summary Judgment of Invalidity and Non-Infringement, with Exhibits A-E, filed March 7, 2005	
48.	Declaration of Katherine L. Parker in Support of Scantibodies' Reply Motion For Summary Judgment of Invalidity and Noninfringement, with Exhibits 1-4, filed March 14, 2005	
49.	Deposition of Claude D. Arnaud, taken on February 1, 2005	
50.	Deposition of Gerald Bjorge, taken on January 27, 2005	
51.	Deposition of Thomas Cantor, taken on August 27, 2003	
52.	Deposition of Thomas Cantor (30(B)(6)), taken on September 11, 2003	
53.	Deposition of Damon Cook, taken on June 16, 2003	
54.	Deposition of Damon Cook (30(B)(6)), taken on September 12, 2003	
55.	Deposition of Joseph O. Falkinham, taken on January 21, 2005	
56.	Deposition of Wolf-Georg Forssmann, Ph.D., taken on August 25, 2003	
57.	Deposition of Ping Gao, M.D., taken on June 18, 2003	
58.	Deposition of Allen Garrett, taken on May 20, 2005	
59.	Deposition of Thomas Godemeyer, taken on October 6, 2004	
60.	Deposition of Mark Gray, taken on June 16, 2003	
61.	Deposition of Dr. Richard Lerner, taken on January 13, 2005	
62.	Deposition of Dr. Richard Lerner, taken on March 16, 2005	
63.	Deposition of Markus Magerlein, Ph.D., taken on May 28, 2003	
64.	Deposition of Markus Magerlein, Ph.D., taken on August 10, 2004	
65.	Deposition of Michael Nordstrom (30(B)(6)), taken on September 17, 2003	
66.	Deposition of K. Ramakrishnan, Ph.D., (30(B)(6)), taken on August 13, 2003	
67.	Deposition of K. Ramakrishnan, Ph.D., (30(B)(6)), taken on September 3, 2003	
68.	Deposition of Stephen Scheibel, taken August 8, 2003	
69.	Deposition of Janet Sharp, taken on August 19, 2003	
70.	Deposition of Randolph Wall, taken January 31, 2005	
71.	Deposition of J. Stuart Woodhead, taken January 18, 2005	
72.	Deposition of Zan Yang, Ph.D., taken on June 16, 2003	
73.	Nichols Institute Diagnostics, Inc.'s Notice of and Ex Parte Application for Order to File Its Consolidated Confidential Declaration of April M. Alex in Support of (1) Nichols Institute Diagnostics, Inc.'s Motion for Judgment as a Matter of Law Re: Willfulness and in the Alternative for a New trial and (2) Nichols Institute Diagnostics, Inc.'s Motion For Enhanced Damages Under Seal, filed January 27, 2006	
74.	Consolidated Confidential Declaration of April M. Alex in Support of (1) Nichols Institute Diagnostics, Inc.'s Motion for Judgment as a Matter of Law Re: Willfulness and in the Alternative for a New trial and (2) Nichols Institute Diagnostics, Inc.'s Motion For Enhanced Damages, filed January 27, 2006	
75.	[Proposed] Order Granting Nichols Institute Diagnostics, Inc.'s Ex Parte Application to File Its Consolidated Confidential Declaration of April M. Alex in Support of (1) Nichols Institute	

Examiner Signature	/Changhwa Cheu/
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		Diagnostics, Inc.'s Motion for Judgment as a Matter of Law Re: Willfulness and in the Alternative for a New trial and (2) Nichols Institute Diagnostics, Inc.'s Motion For Enhanced Damages Under Seal, filed January 27, 2006, order signed Judge Brewster on January 31, 2006	
	76.	Confidential Deposition of Tom Cantor, taken on July 11, 2005	
	77.	Memorandum of Points and Authorities in Support of Defendants' and Counterclaimants' Motion for Summary Judgment for Failing to Disclose the Best Mode, filed November 13, 2007	
	78.	Declaration of Matthew A. Newboles in Support of Defendants' and Counterclaimants' Motion for Summary Judgment for Failing to Disclose the Best Mode, filed November 13, 2007	
	79.	Memorandum of Points and Authorities in Support of Defendants' and Counterclaimants' Motion for Summary Judgment of Patent Invalidity for Violation of On Sale Bar and for Obviousness over the Prior Art, filed November 13, 2007	
	80.	Declaration of Matthew A. Newboles in Support of Defendants' and Counterclaimants' Motion for Summary Judgment of Patent Invalidity for Violation of On Sale Bar and for Obviousness over the Prior Art, filed November 13, 2007	
	81.	Memorandum of Points and Authorities in Support of Defendants' and Counterclaimants' Motion for Summary Judgment of Patent Invalidity for Lack of Enablement, filed November 13, 2007	
	82.	Declaration of Matthew A. Newboles in Support of Defendants' and Counterclaimants' Motion for Summary Judgment of Patent Invalidity for Lack of Enablement, filed November 13, 2007	
	83.	Memorandum of Points and Authorities in Support of Defendants' and Counterclaimants' Motion for Summary Judgment of Non-Infringement of the '566 Patent, filed November 13, 2007	
✓	84.	Declaration of Jeffrey Lavigne in Support of Defendants' and Counterclaimants' Motion for Summary Judgment Based on Non-Infringement of the '566 Patent, filed November 13, 2007	

\*EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.

<sup>1</sup>Applicant's unique citation designation number (optional). <sup>2</sup>Applicant is to place a check mark here if English language Translation is attached.

NON PATENT LITERATURE DOCUMENTS – PROPRIETARY INFORMATION			
Examiner Initials <sup>1</sup>	Cite No. <sup>1</sup>	Include name of the author (in CAPITAL LETTERS); title of the article (when appropriate); title of the item (book, magazine, journal, serial, symposium, catalog, etc.); date, page(s), volume-issue number(s), publisher, city and/or country where published.	<sup>2</sup>
ICN	85.	Declaration of Thomas L. Cantor with Exhibit A, executed on April 7, 2005	

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